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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,701	08/28/2003	Atsushi Nagasawa	241985US0	6751
22850	7590	01/10/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			OWENS, AMELIA A	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 01/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/649,701

Applicant(s)

NAGASAWA ET AL.

Examiner

Amelia A. Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/17/2005
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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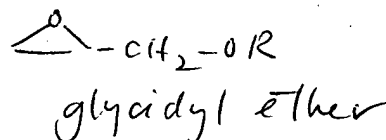
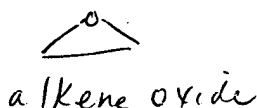
**DETAILED ACTION**

1. Claims 1,2 have been canceled. Claims 3-24 are pending.

***Claim Rejections - 35 USC § 103***

2. Claims 3-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over CA 135:363159 and CA 124:282468 that correspond to JP 2001-327866 and JP 2001-096153 respectively for the reasons of record.

Applicant's comments have been considered but are not persuasive. The JP references clearly teach the claimed catalyst. Note Table 1 on page 10 of the translation, particularly examples 3 and 4. The catalysts are similar to those claimed, i.e. they contain Mg in combination with an element of the 3<sup>rd</sup> or 4<sup>th</sup> period in the periodic table, namely Al. The fact that NaOH is the conventional catalyst for producing glycidyl ether adducts does not negate the teachings of the JP references. The JP references clearly teach using the claimed catalyst in an addition reaction involving an alkene oxide. Glycidyl ethers may be seen as a type of alkene oxide based on the structure depicted below.



It is the examiner's position that applicants have merely used a member of a known class of materials. Again, use of a known member of a class of materials in a process is not patentable if other members of the class were known to be useful for that purpose. Here, note glycidyl ether is an alkylene oxide (see above); the hydrogen containing compound language of the claim and prior art is broad enough to overlap; it is an addition reaction; the catalyst contains the same elements; Mg, Zn, Al; the product is the same, namely an alkylene oxide adduct.

From the translation of JP '866 page 6 paragraph 14, it can be seen that the claimed Mg containing catalyst was used to obtain higher alkene oxide selectivity than was achieved with the conventional NaOH catalyst. Note paragraph 15 defines the active hydrogen compound the same as applicant.

Applicants comments regarding the data in the specification is noted. The greater selectivity is noted. The greater selectivity would be expected given the teachings of JP '866

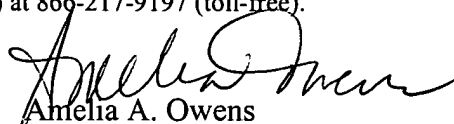
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paragraph 14. However, the comparison is not with the closest prior art which is the catalyst of the JP references. The examiner recognizes that applicant need not make such a comparison.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amelia A. Owens  
Primary Examiner  
Art Unit 1625